



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP AF
Takeo Katsuda)	Group Art Unit: 2145
Application No.: 09/880,039)	Examiner: THOMAS DUONG
Filing Date: June 14, 2001)	Confirmation No.: 5950
Title: APPARATUS, PORTABLE TERMINAL)	
UNIT, AND SYSTEM FOR)	
CONTROLLING E-MAIL, AND ITS)	
METHOD, COMPUTER-READABLE)	
RECORDING MEDIUM AND)	
PROGRAM PRODUCT FOR)	
PROCESSING E-MAIL)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated below.

Claims 14-31 and 37-47 are pending in the present application.

In the final Office Action, claims 14-31 and 37-47 were rejected under 35 U.S.C. § 102(e) as being anticipated by Miller et al. (US006421707B1).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner bears the burden of identifying or at least explaining where each and every claim element can be found in the applied prior art. In this instance, the Examiner has not met that burden. There is at least one element in each of the independent claims which has not been established to be in the prior art references.

For purposes of this Request, the independent claims can be divided into two groups, each of which recites at least one element that is not in the references.

Claims 15 and 37-44

Independent claim 15 recites a device that selects one of multiple image output devices and "a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device." Thus, an email is sent to the portable terminal, and this email identifies an image output device on which data is to be output. Independent claims 37-44 recite a similar notifying feature as independent claim 15.

In the response filed March 2, 2007, the Applicant pointed out that the Miller patent does not disclose an E-mail being sent to a portable terminal unit containing a notification of the image output device selected by a selecting device. See, in particular, pages 2-3 of the response.

In the Advisory Action dated April 2, 2007, the Examiner based his rebuttal on the passage of the Miller patent at column 1, lines 52-58, which states:

Upon receipt of the message, the network determines an appropriate action to take with respect to the message based upon a profile of the subscriber. The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network. (emphasis added)

There is no mention in this passage of an e-mail containing a notification of the image output device being sent to the portable terminal unit. The Miller patent describes a notification acknowledging receipt of a message and delivery of the message to an output device indicated by the subscriber.

In the Advisory Action, the Examiner points to Figures 4(j), 4(n), 4(q) and 4(t) of the Miller patent, as disclosing the claimed features. Each of these figures merely presents choices, i.e., a menu, to the subscriber so the subscriber can choose how to receive the attachments.

First, the Office Action does not establish that this menu is provided by means of an email that is sent to the handset of the subscriber. Rather, the logical assumption is that the menu is displayed by software within the handset.

Second, this menu does not provide notification of an image output device that has been selected by a selecting device and sent to the handset. Instead, it is the mechanism by which the user makes a selection, which is then transmitted from the handset.

In the context of the Miller patent, there is no reason to send an email to the subscriber containing a notification of the image output device selected by the selecting device. In particular, the subscriber uses the menu of Figure 4(j) to choose an image output device X. As such, why would it be necessary to send him an E-mail informing the subscriber that he or she just chose image output device X?

At page 3, the end of numbered paragraph 2 of the Advisory Action, the Examiner concisely describes the teaching of Miller:

Hence, Miller teaches of the subscriber confirming with the system in using SMS as the selected delivery method via a display 412 of the handset 411. In other words, Miller teaches of the system presenting SMS as one of the selected delivery method to the subscriber and that the subscriber confirming with the system of using SMS as the delivery method via the display of the handset.

This statement does not address the claimed subject matter. The fact that the subscriber chooses to use SMS, i.e., a messaging service, as a "delivery method" has nothing to do with providing notification of a selected image output device on which data of a received email is to be output. How the user chooses to receive a message is entirely distinct from informing the user of the device on which data is to be output.

For at least this reason, the final Office Action fails to show that the Miller patent discloses every element recited in claim 15. Since each of claims 37-44 also recites this notification feature, the Office action has not established the requisite support for the rejection.

Claims 14 and 31

Independent claims 14 and 31 recite an E-mail transmitting device transmitting to said portable terminal unit a receipt notice E-mail prepared by said E-mail preparing device and "an E-mail identifying multiple prospective image output devices."

In the response filed March 2, 2007, the Applicant pointed out that the Miller patent does not disclose E-mail transmitting device transmitting to said portable terminal unit a receipt notice E-mail prepared by said E-mail preparing device and "an E-mail identifying multiple prospective image output devices." See, in particular, page 4 of the response.

In the Advisory Action, the Examiner rebuts the Applicant's arguments with a similar argument as presented with respect to claim 15 by referring to Miller's Figures 4(j), 4(n), 4(q) and 4(t). As stated by the Examiner, Miller teaches a system presenting the subscriber with the system selected outputting means.

However, the Office Action does not establish that this menu is presented by means of an email that is sent to the handset of the subscriber. Rather, the logical assumption is that the menu is displayed by software within the handset.

Second, this menu does not provide an email identifying multiple prospective image output devices to the hand set. Instead, it is the mechanism by which the user makes a selection, which is then transmitted from the handset.

The Miller patent does not disclose the features recited in independent claims 14 and 31.

For at least this reason, the final Office Action fails to show that the Miller patent discloses every element recited in claims 14 and 31.

Rejections under 35 USC 103

Claims 14-31 and 37-46 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Theimer et al. All the features of the claims have not been identified or explained in a manner that suggests the claimed features.

One criteria for establishing a prima facie case of obviousness is that all features of the claimed invention be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

As discussed previously, there has been no showing that Miller patent discloses or suggests sending an e-mail containing a notification or an E-mail identifying multiple prospective image output devices, as recited in the independent claims.

As stated at page 17 of the final Office Action, the Examiner is relying on the Thieme patent for its alleged disclosure of the claimed features of a location information acquiring device and a selecting device. However, the Office Action does not show that the Thieme patent overcomes the deficiencies of the Miller patent outlined above.

Neither the Miller patent nor the Thieme patent, either individually or in combination, disclose or suggest all of the features recited in independent claims 14, 31 and 44 and those that depend therefrom.

As for independent claims 15 and 37-44, these claims recite a feature of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device, or sending an E-mail to said destination containing a notification of the selected image output device. As discussed above, the Miller patent does not disclose these features, and the Theimer patent does not overcome the deficiencies of the Miller patent.

The Miller and Theimer patents, either individually or in combination, do not disclose or suggest all of the features recited in dependent claims 15 and 37-44.

Finally, claim 47 was rejected under 35 U.S.C. §103(a) over the combination of the Miller and Theimer patents, further in view of the Glorikian patent.

The Glorikian patent, cited in the rejection of claim 47, does not overcome the deficiencies of the Miller and Theimer patents with respect to the feature claimed in claim 15 of a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by the selecting device. Therefore, the Glorikian, Miller and Theimer patents, either individually or in combination, do not disclose or suggest all of the features recited in dependent claim 47.

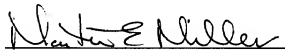
In conclusion, the final Office Action does not meet the burden of showing that the references disclose every element recited in the claims, as required to support a rejection under 35 USC 102 or 103. Accordingly, the application is not in appropriate condition to send to the Board of Patent Appeals and Interferences. Applicant respectfully requests that the rejections of record be withdrawn.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: April 9, 2007

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